

REMARKS

The June 8, 2006 Office action stated that it was responsive to the Pre-Appeal Brief filed by the Applicants on April 25, 2006. Significantly, in the Pre-Appeal Brief, the Applicants argued that the rejection of claims 1, 4-6, 9, 12, 13, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Abrams et al. (5,341,818) in view of Gambale et al. (5,031,636) was not sufficient to establish a *prima facie* case of obviousness. Moreover, the Applicants argued that the rejection of claims 2, 3, 7, 8, 10, 11, 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Abrams et al./Gambale et al. was also insufficient to establish a *prima facie* case of obviousness. In support of the Applicant's position, it was argued that there was no motivation to combine the teachings of Abram et al. and Gambale et al. and even if there was sufficient motivation, the cited art did not meet the "permanently" secured/securing limitation recited in each of the pending claims.

In the outstanding Office action, the Examiner again relies upon the Abrams et al. and Gambale et al. references to reject the claims. That is, in the outstanding Office action, claims 1, 4-6, 9, 12, 13 and 18 have been rejected under § 102(b) in view of Gambale et al.; claim 19 was rejected under § 103(a) in view of Gambale et al. and Abrams et al.; and claims 2, 3, 7, 8, 10, 11, 14 and 15 were rejected under § 103(a) in view of Gambale et al. Accordingly, in view of the use of the same art to reject the pending claims as that which was overcome by the Applicant's Pre-Appeal Brief, the Applicants respectfully request that the June 8, 2006 Office action be withdrawn.

It is respectfully submitted that the Gambale et al. reference does not teach each and every limitation recited in claims 1, 4-6, 9, 12, 13 and 18 as is required under § 102(b). Clearly, Gambale et al. does not teach permanently securing the male end of the first elongate member within the female end of the second elongate member as is required by method claim 1 and its dependent claims 2-8. Further, Gambale et al. does not teach a male end which is permanently secured within a female end as is recited in

claims 9-15 and 18. In fact, Gambale et al. teaches that "the connection maybe broken easily and quickly should it be desired to separate the guide wire extension 24 from the guide wire 12" (See Column 7, line 23 et seq.). Notably, the section of Gambale et al. upon which the Examiner has relied (Column 7, lines 42-44) does not actually address permanently securing a male end (36) within a female end (26). Therefore, it is respectfully submitted that each of pending independent claims 1, 9 and 18 as well as their respective dependent claims recite subject matter which is allowable over the Gambale et al. reference.

Specifically with regard to the rejection of independent claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Gambale et al. in view of Abrams et al., it is again respectfully submitted that there is no motivation to combine the teachings of Gambale et al. and Abrams et al. As previously stated, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Also, the MPEP advises that "a statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the invention was made' because references relied upon teach all of the aspects of the claimed invention or individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." Moreover, the MPEP states that "the level of skill in the art can not be relied upon to provide the suggestion to combine the references."


In the present situation, it is respectfully submitted that an objective reason has not been presented to modify Gambale et al. in view of Abrams et al. In the outstanding Office action, the Examiner states that it would have been obvious to one of ordinary skill in the art to modify Gambale et al. with the teachings of Abrams et al. "so as to achieve stress-induced phase transformation." However, since Gambale et al. is not concerned with achieving "stress-induced phase transformation," there is no suggestion or

motivation in Gambale et al. to modify its teachings as suggested by the Examiner. Moreover, Column 4, lines 25-30 of Abrams et al. upon which the Examiner relies as a teaching of a "distal core portion and female end being formed from a second continuous material including a nickel-titanium alloy" does not actually address the recitation in claim 19 of a "distal core portion and female end being formed from a second continuous material." Rather, Abrams et al. describes connector element 13 which is a separate and distinct structure from that of distal portion 12 of the guide wire. Therefore, it is respectfully submitted that claim 19 also defines patentable subject matter.

CONCLUSION

Applicants have attempted to completely respond to the rejections set forth in the outstanding Office action. In view of the above amendments and remarks, Applicant respectfully request that the application be reconsidered, the claims allowed and the application passed to issue.

Respectfully submitted,
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